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09/529,255	04/11/2000	TAKANORI SHINOKI	2000-0465A	5270

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EXAMINER

GUARRIELLO, JOHN J

ART UNIT

PAPER NUMBER

1771

6

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529255

Applicant(s)

Shinobu et al.

Examiner

John Guarniello

Group Art Unit

1771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/11/2000.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 1 1/2, 5
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims merely setting forth physical characteristics desired in an article, like the support member of the claimed invention, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the

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future and which would impart desired characteristics; thus the expression support member for a semipermeable membrane with the stated properties in the claims is too broad and it appears to read upon materials that could not possibly be used to accomplish the purposes intended. See Ex Parte Slob (BdPatApp&Int) 157 USPQ 172.

In claim 4, lines 4 and 5, the use of the "and/or" language is not clear. This is improper use of "and/or" language as present in line 4 and line 5.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 7, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP- 10-174849.

JP'849 describes an ultra filtration apparatus comprising a pair of ultra filtration membranes attached to both sides of a metal or plastic support plate, (see abstract). JP'849 describes a permeation water passage layer (like a support member) made up of non-woven fabric which is interposed between the support plate and each filtration membrane, (see abstract). JP'849 describes the density of the non-woven is 0.4-0.95 g/cc., (see abstract). JP'849 describes the tensile strength and the permeability of the permeability layer is restricted to 3-20 kg/ 15mm width and 5-20 cm³(cc)/cm²(sq.cm.)/second(s), (see abstract). JP'849 describes the non-woven to be polyester, [0007] and a support component, [0009] (per oral translation of JP'849). JP'849 describes the essential limitations to the claimed invention, other properties would be inherent. Claims lack novelty.

Claim Rejections - 35 USC § 103

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18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-10-174849.

JP'849 as above except JP'849 describes a component which can be considered **a support member** or **the support member** for a semi permeable membrane except for the particular amount of polyester non-woven and parameters as claimed. Note applicant's "comprising" is open language and does not exclude any additional elements described herein. Note that any properties of characteristics inherent in the prior art, although unobserved or detected by the reference, would still anticipate the claimed invention. See In re Swinehart, 169 USPQ 226. "It is elementary that the mere recitation of a newly discovered... property, inherently possessed by things in the prior art

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does not casue claim drawn to those things to distinguish over the prior art".

Since the claimed parameters are expressed differently and thus may be distinct from those claimed, it is incumbent upon applicants to establish that they are in fact different and whether such difference is unobvious. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the particular elements and/or parameters as claimed, since it is well established that merely selecting proportions and ranges is not patentable absent a showing of criticality. In re Becket 33 USPQ 33(CCPA 1937). In re Russell, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is (703) 308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The

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fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John J. Guarriello:gj

Patent Examiner

February 19, 2002

February 25, 2002



ELIZABETH M. COLE
PRIMARY EXAMINER